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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,259	03/29/2001	Mark M. Ishikawa	60123.801US01	7236

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,259

Applicant(s)

ISHIKAWA, MARK M.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-13 have been examined.

#### *Response to Amendment*

2. The Amendment filed on 12/3/04 is insufficient to overcome the Angles reference.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles (5,933,811).

Claim 1, 7, 9: Angles discloses a method, system for authenticating the distribution of an advertisement for data and a request for the data in response to the advertisement on a network having at least one user computer and one provider computer, wherein the response to the advertisement is preceded by the distribution of the advertisement to the user computer from an advertiser, comprising:

creating a confirmation code upon the transmission of the advertisement to the user computer; wherein the confirmation code comprises a first user code (col 3, lines 17-29; col 8, lines 8-16);

associating the confirmation code with the advertisement (col 19, lines 7-11);

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transmitting a request from the user computer for the data identified in the advertisement to the provider computer (col 20, lines 16-26);

transmitting a second user information piece generated by the transmission protocols to the provider computer (col 20, lines 47-57; col 7, lines 10-42);

transmitting the confirmation code to the provider computer (col 8, lines 7-15); .

determining the authenticity of the data request from the user (col 22, lines 41-50).

Angles further discloses a data interface (col 3, lines 24-30; col 20, lines 16-26).

Additionally, the above features are disclosed in the Figures (Fig. 1, Fig. 4, Fig. 7, Fig. 11).

Angles further discloses preassigning a content provider code (col 3, lines 30-40) and uniquely identifying an advertiser (col 21, lines 5-25; col 25, lines 5-8).

Angles does not explicitly disclose that the second user information piece are codes.

However, Angles discloses that the second user information is categorized and grouped (col 20, lines 53-60) and Angles discloses utilizing codes (col 3, lines 23-26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Angles's information that is to be grouped and categorized can be in the form of codes. One would have been motivated to do this in order to provide the information in a form that is easily transmittable and easily grouped or categorized.

Claim 2, 10: Angles discloses a method as claimed in claim 9, wherein determining the authenticity of the data request further comprises comparing a portion of the identifying indicia and the second user code (col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25).

Claim 3, 11: Angles discloses a method as claimed in claim 9.

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Angles does not explicitly disclose an advertiser code.

However, Angles discloses a content provider code (col 3, lines 30-40) and uniquely identifying an advertiser (col 21, lines 5-25; col 25, lines 5-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angle's identity identifying codes to Angle's uniquely identifying and advertiser. One would have been motivated to do this in order to provide an effective way to uniquely identify an advertiser.

Claim 4, 12: Angles discloses a method as claimed in 11, wherein the creating of a confirmation code comprises dynamically generating the first user code and combining the first user code and advertiser code (col 19, lines 1-11).

Claim 5: Angles discloses a method as claimed in claim 1, wherein the user computer and provider computers operate in accordance with transmission protocols, and further comprising dynamically generating the second user code via the transmission protocols (col 7, lines 10-42; col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25).

Claim 6, 8: Angles discloses a method as claimed in claim 1, further comprising:  
comparing, on the provider computer, a portion of the identifying indicia with the second user code to determine a degree of match; and

providing, from the provider computer, information regarding the degree of match determined by comparing the portion of the identifying indicia and second user code (col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25; col 11, lines 20-25).

Claim 13: Angles discloses a method as claimed in 11, further comprising storing the advertiser code in a database in association with the advertiser (col 21, lines 5-25).

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-13 have been considered but are not considered persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that several of the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Examiner notes that a 35 USC 103(a) rejection was made utilizing Angles. Therefore, the disclosure of Angles does not explicitly state all the Applicant's features. Rather, the disclosure of Angles would render obvious to one skilled in the art the Applicant's claimed invention.

Claim 1 does not utilize the word 'dynamic'. Claim 1 states that the identifying indicia are created upon transmission of the data interface to the user computer. Claim 1 does not state that the identifying indicia comprise a user identification code and the advertiser code. Claim 1 states that the identifying indicia comprise a first user code. Claim 1 does not state what the second user code comprises.

The 'data interface' of claim 1 is ambiguous. The data interface could be special software that the user will utilize to access the content. The data interface could be a browser that the user will utilize to access the content. The data interface could be the window that is displayed where the user can click to obtain more information. Angles discloses both a special software data interface (col 3, lines 24-30) and a browser data interface (col 1, lines 45-55; col 4, lines 26-35). Angles discloses creating identifying indicia upon user registration (col 17, lines 10-25) and creating identifying indicia upon providing a specialized data interface (col 3, lines 20-30).

Claim 1 or Claim 7 do not state that multiple identifying indicia or multiple data interface are transmitted. Claim 1 or Claim 7 can be interpreted as one data interface being transmitted and one identifying indicia being created at that time of data interface transmission.

Claim 8 is dependent upon Claim 7 and Claim 8 states 'a second user code'. However, there is no prior stated 'second user code'. Hence, the second user code of claim 8 can be open to a wide variety of interpretations. The user computer generates codes for identifying which advertisements from the user computer were viewed or not (Fig. 4, item 12; Fig. 11, item 12; col 19, lines 1-11).

Claim 9 does not use the word 'dynamic' nor state the confirmation code is a combination of the dynamically generated user identification code and advertiser code. The only specifying features about what the 'confirmation code' in claim 9 consists of is that the 'confirmation code comprises a first user code'.

Angles uniquely identifies each advertisement that the user views or requests to view (col 20, lines 15-37).

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Angles uniquely identifies a variety of the actions taken or information displayed by or to the user (col 19, lines 1-11). Angles uniquely identifies when an advertisement is sent to the user, uniquely identifies when a link is provided to the user for clicking on to see an advertisement, and uniquely identifies when the user requests to see that advertisement. Angles was combined with itself to demonstrate that codes can be utilized for these uniquely identified actions and information transmission back and forth.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

12/29/04

**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**

